REMARKS

In the Office Action mailed May 31, 2005, claims 1-43 were rejected under 35 U.S.C. 112, second paragraph. Next, claims 1-43 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 4,725,647 (hereinafter referred to as "Maresca et al."). Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-43 remain active in the application. Claims 1, 7-12, 21, 25, 32-34, and 36-38 have been amended to more clearly recite the present invention and not to overcome the prior art. No new matter has been added.

Claims 1-43 were rejected under 35 U.S.C. 112, second paragraph. The Examiner states that the term "combining" in claim 1 etc. is unclear terminology. Independent claims 1, 25, and 32 have been amended to recite, in part, the step of "heating a mixture comprising at least one aromatic diol, at least one dicarboxylic acid, and at least one diaryl carbonate in the presence of a catalyst". Support for the claims can be found, for example, in Examples 1-6. The terminology "combining" has been omitted from the claims, thereby obviating the basis for the rejection. Hence, the rejection of claim 1-43 under 35 U.S.C. 112, second paragraph is now moot and should now be withdrawn.

With regard to claim 32, the Examiner requires clarification to the terminology "mixture". Applicant respectfully submits that claim 32 has been amended to recite, in part, "heating a mixture comprising 1,3-dihydroxybenzene, a dicarboxylic acid mixture of isophthalic acid and terephthalic acid, and diphenyl carbonate in the presence of a

titanium tetrabutoxide catalyst and a sodium dihydrogen phosphate co-catalyst". The amendment to claim 32 clarifies the terminology that the Examiner cites as being indefinite thereby obviating the basis for the rejection. Accordingly, it is respectfully requested that the rejection of claim 32 under 35 U.S.C. 112, second paragraph should now be withdrawn.

Claims 1-43 were rejected under 35 U.S.C. 102(b) as being anticipated by Maresca et al.

The present disclosure is concerned with the preparation of hydroxyl-terminated arylate oligomers. The hydroxyl-terminated arylate oligomer is prepared by heating a mixture comprising at least one aromatic diol, at least one dicarboxylic acid, and at least one diaryl carbonate in the presence of a catalyst selected from the group consisting of metal alkoxides, metal oxides and metal carboxylates; and applying a vacuum to prepare a hydroxy-terminated arylate oligomer. See, for instance, independent Claims 1, 25, and 32.

Maresca et al. generally discuss a process for the preparation of polyesters. A dihydric phenol is reacted with a diester derivative of an aromatic diacid in the presence of a processing aid. See Claim 1.

Maresca et al. do not teach, suggest, or disclose the recited invention as claimed in independent claims 1, 25, and 32. Specifically, Maresca et al. do not teach, suggest, or disclose a method of heating at least one aromatic diol, at least one dicarboxylic acid, and at least one diaryl carbonate in the presence of a catalyst selected from the group consisting of metal alkoxides, metal oxides and metal carboxylates; and applying a vacuum to prepare a hydroxy-terminated arylate oligomer. In particular, Maresca et al.

fail to discuss preparing a hydroxy-terminated arylate oligomer via the direct reaction of at least one aromatic diol, at least one dicarboxylic acid, and at least one diaryl carbonate in the presence of a catalyst. In contrast, Maresca et al. make use of a diester derivative of an aromatic diacid to prepare a polyester. Maresca et al. make no mention of preparing a polyester without the use of a diester derivative of an aromatic diacid. Indeed, the preparation of the diester derivative of the aromatic diacid is an essential part of the invention of Maresca et al.

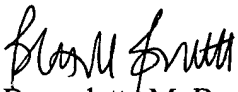
"Anticipation requires the presence in a single prior art reference disclosure each and every element of the claimed invention, *arranged as in the claim.*" *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 U.S.P.Q. 481, 485 (Fed. Cir. 1984) (emphasis added). "[T]he [Examiner] must identify the elements of the claims, determine their meaning in light of the specification and prosecution history, and identify corresponding elements disclosed in the allegedly anticipating reference." *Lindemann Maschinenfabrik GmbH*, 221 U.S.P.Q. at 485. Therefore, anticipation cannot be found in a situation where the claimed elements are arranged differently in the prior art. Furthermore, it is error to "treat the claims as a mere catalog of separate parts, in disregard of the part-to-part relationships set forth in the claims . . . that give the claims their meanings." *Id.* at 486. Since Maresca et al. provide no guidance or motivation for one skilled in the art to make a polyester without preparing the diester derivative of the aromatic diacid, the present invention as recited in independent claims 1, 25, and 32 is not anticipated by Maresca et al.

Claims 2-24, 26-31, and 33-43 depend either directly or indirectly from independent claims 1, 25, and 32 and are therefore believed to also be allowable for the

reasons set forth above. In addition, the dependent claims set forth further limitations which patentably distinguish the invention over all the prior art of record. Accordingly, it is respectfully requested that the rejection of claims 1-43 under 35 U.S.C. 102(b) should now be withdrawn.

In view of the foregoing amendment and for the reasons set out above, it is respectfully submitted that claims 1-43 which stand rejected in this application, are patentably distinct from the art cited in the Office Action and are now in condition for allowance. Favorable action on these claims is requested.

Respectfully submitted,



Bernadette M. Bennett
Reg. No. 44,532
Attorney for Applicant

CARTER, DELUCA, FARRELL & SCHMIDT, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
Tel (631) 501-5700
Fax (631) 501-3526